

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No: 09/593,914 Confirmation No. 8319  
Date Filed: June 14, 2000  
Application Title: Probes, Probe Sets, Methods And Kits Pertaining To The  
Detection, Identification And/Or Enumeration Of Yeast;  
Particularly in Wine  
Applicant: Hyldig-Nielsen et al.  
Group Art Unit: 1634  
Examiner: C. Meyers  
Application Status: Pending – Prosecution Open  
Action Type: Non-Final Office Action issued on March 10, 2005

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Certificate of Mailing Pursuant to:  
37 C.F.R. § 1.8

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Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 22<sup>nd</sup> day of July, 2005.

  
Brian D. Gildea  
Reg. No. 39,995

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Petition Under 37 C.F.R. § 1.144 or § 1.181

Commissioner for Patents  
Dear Sir or Madam:

Preliminary Statement

In the above captioned application, the Examiner issued a renewed restriction requirement by action dated October 26, 2004. Applicant did enter traverse of said restriction requirement as well as make appropriate arguments and present a request for reconsideration, in reply to said action, by submission dated December 1, 2004. This petition is filed in response to the Examiner's determination that the restriction requirement is deemed proper and thereby made final as stated in paragraph 1 of the

Office Action dated March 10, 2005. In view of the arguments set forth below, Applicants hereby request review of said renewed restriction requirement.

It is noted that this Petition follows a previously successful challenge to the restriction requirement issued in paper number 9 dated July 18, 2001. Relevant papers associated with that petition are:

- Paper No. 9 dated July 18, 2001
- Applicant's response dated January 17, 2002
- Applicant's petition under 37 C.F.R. § 1.144 dated August 22, 2003
- The Decision on Petition dated March 3, 2004 – Petition Denied
- Applicant's request for reconsideration dated April 27, 2004
- Decision on Petition dated August 3, 2004 – Petition Granted

#### **Argument In Support Of A Request To Withdraw The Restriction Requirement**

a) The Restriction Requirement is based on 35 U.S.C. § 121

In support of the restriction requirement the Examiner stated:

*"Restriction to one of the following inventions is required under 35 U.S.C. § 121:"*

(Action dated October 26, 2004 at page 2)

From the foregoing, it is clear that the restriction requirement rests on "misjoinder of invention" under 35 U.S.C. § 121 and on no other basis. More specifically, the restriction requirement is not based upon "improper Markush grouping".

b) Nature of the Restriction Requirement & Arguments in Support Thereof

According to the Restriction Requirement, Applicants must choose to prosecute only one of 11 different groups of claims wherein the claims identified with each group are identical but are distinguished by each different SEQ ID NO associated with the claims of the group. In support of the restriction requirement, the Examiner has argued that, "the probes of SEQ ID NO: 1-11 are considered to be unrelated since each of the claimed sequences are structurally and functionally distinct from each other." (Office Action dated October 26, 2004 at page 4). In denying Applicant's request for reconsideration of the Restriction Requirement, the Examiner reiterated that each of the

SEQ ID NO: 1-11 are distinct and that the a search of all of the sequences would be a burden to The Office despite all being classified in Class 536, subclass 24.32 and Class 435, subclass 6.

c) The M.P.E.P. does not Overrule Statute or Judicial Precedent

As a preliminary matter, Applicant submits that it is self-evident that the Manual of Patent Examining Procedure (M.P.E.P.) must be consistent with, and not contravene, statute or judicial precedent. It is further submitted that any part of the M.P.E.P. that is inconsistent with statute or judicial precedent is improper and must not be followed.

d) The Subject Matter of the Present Controversy is Resolved by *In re Weber*

*In re Weber* holds that:

*"It is apparent that § 121 provides the Commissioner with the authority to promulgate rules designed to Restrict an Application to one of several claimed inventions when those inventions are found to be "independent and distinct". It does not, however, provide a basis to an examiner acting under the authority of the Commissioner to Reject a particular Claim on that same basis."*

( *In re Weber*, 580 F.2d 455, 458, 198 U.S.P.Q. 328, \_\_ (CCPA, 1978))

*"We hold that a rejection under § 121 violates the basic right of the applicant to claim his invention as he chooses." (emphasis added).*

(*In re Weber*, 580 F.2d 455, 459, 198 U.S.P.Q. 328, \_\_ (CCPA, 1978))

Thus, it is clear from *In re Weber* that the legal issue of whether or not The Office may impose a restriction requirement to a **single claim** has been decided against The Office. It is well settled that such a requirement violates 35 U.S.C. 112, where the applicant is statutorily entitled to claim his invention as he deems proper, notwithstanding 35 U.S.C. § 121. **This is true whether or not the inventions are determined by The Office to be independent and distinct.** Accordingly, the Examiner's holding that the inventions classified in Groups I-XI are distinct is irrelevant, even if true, because, according to *In re Weber*, this determination is not dispositive as to whether or not a restriction requirement is proper.

e) The Restriction Requirement should be an Election Requirement

i) *The Restriction Requirement Ignores The Mandate of M.P.E.P. § 803.02*

M.P.E.P. § 803.02 states:

*"Since the decisions in In re Weber, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and In re Haas, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention." In re Harnish 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and Ex parte Hozumi, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility."*

(M.P.E.P. § 803.02)

Thus, M.P.E.P. § 803.02 expressly states that it is acceptable for a Markush claim to include independent and distinct inventions. Moreover, the section mandates election practice and not restriction practice. For example M.P.E.P. § 803.02 expressly reads:

*"This subsection deals with Markush-type generic claims which include a plurality of alternatively usable substances or members. In most cases, a recitation by enumeration is used because there is no appropriate or true generic language. A Markush-type claim can include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 V.S.C. 103 with respect to the other member(s). In applications containing claims of that nature, the examiner may require a provisional election of a single species prior to examination on the merits. The provisional election will be given effect in the event that the Markush-type claim should be found not allowable. Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability." (emphasis added)*

(M.P.E.P. § 803.02)

Accordingly it is clear that the Examiner has misapplied the directives of M.P.E.P. § 803.02 and therefore the Restriction Requirement is fatally flawed. Moreover, it is clear from M.P.E.P. § 803.02 that the correct way to proceed with Applicant's claims is to issue

an election, not a restriction, requirement if the Examiner is so inclined. It is noted that an election requirement is permissive and not mandatory. That is why the word "may" is used in the text quoted from M.P.E.P. § 803.02, above.

f) **Understanding & Applying *In re Harnisch***

It is respectfully submitted that the holding of *In re Harnisch* is applicable to the case at hand. In particular, Applicants submit that much of the argument the Examiner makes in support of maintaining the restriction requirement pertains to the issue of whether or not a proper Markush grouping is present and not whether or not the inventions are distinct. In particular, the Examiner has repeatedly suggested that the different sequences do not share the same structural and functional properties. However, this is not the proper test. The proper test is whether or not SEQ ID NOs: 1-11 share a common utility. With respect to what constitutes common utility, *In re Harnisch* expressly states:

*"Over thirty years ago this court decided In re Jones, 34 CCPA 1150, 162 F.2d 479, 74 USPQ 149 (1947), reversing an "improper Markush group" rejection of claims to chemical compounds which were [\*722] growth-regulating compositions for plants, fungicides, and insecticides. Notwithstanding their various properties, the court found all of the compounds included in the claims were plant growth stimulants, thus having a common function. The court noted that in any Markush group the compounds "will differ from each other in certain respects." It laid down the proposition, with which the PTO agrees in its M.P.E.P., that in determining the propriety of a Markush grouping the compounds must be considered as wholes and not broken down into elements or other components." (emphasis added)*

*(In re Harnisch, 631 F.2d 716, 722, 206 U.S.P.Q. 300 \_\_\_\_ (CCPA, 1980)*

In addition to stating the proper test, *In re Harnisch* makes clear that in formulating Markush groupings, it is not proper to focus on trivial distinctions unrelated to the disclosed invention such as melting temperature of a hybrid. Rather, it is proper to consider the compounds, and their associated functions, as a whole as disclosed in the context of the specification.

This position is also supported by M.P.E.P. § 2173.05(h) which reads:

*“The materials set forth in the Markush group ordinarily must belong to a recognized physical or chemical class or to an art-recognized class. However, when the Markush group occurs in a claim reciting a process or a combination (not a single compound), it is sufficient if the members of the group are disclosed in the specification to possess at least one property in common which is mainly reasonable for their function in the claimed relationship, and it is clear from their very nature or from the prior art that all of them possess this property.” (emphasis added)*

(M.P.E.P. § 2173.05(h))

In the present patent application, Applicants claim a PNA probe, a set of PNA probes, methods for using one or more of the PNA probes to determine organisms commonly known in the art as *Dekkera/Brettanomyces* yeast (a group of yeasts associated with the spoilage of wine) as well as kits comprising one or more of the PNA probes in a format suitable to determine said *Dekkera/Brettanomyces* yeast. Thus, the common utility of SEQ ID NOs: 1-11 is the determination of one or more *Dekkera/Brettanomyces* yeast. Because the specification provides a proper basis to group together SEQ ID NOs. 1-11 in a Markush type claim, the holding of *In re Harnisch* as well as M.P.E.P. § 802.03 supports Applicant’s assertion that the restriction requirement is improper. Accordingly, it is respectfully submitted that the Restriction Requirement should be withdrawn.

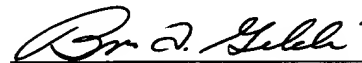
g) Conclusion

In summary, it is clear that the Restriction Requirement fails to embrace and follow the holdings of *In re Webber*, *In re Hass* or *In re Harnisch* as well as fails to follow the relevant sections of the M.P.E.P. and is therefore fatally flawed. Applicants submit that SEQ ID NOs: 1-11 form a proper Markush group and therefore restriction, as proposed by the Examiner in the Restriction Requirement issued on October 26, 2004, is simply improper. Moreover, to the extent The Office wishes to limit the Examiner’s search obligations, election, not restriction, is the proper vehicle to effect that desired outcome (M.P.E.P. § 803.02 and 2173.05(h)). Thus, reconsideration of the Restriction Requirement issued in the Office Action dated October 26, 2004 is hereby requested.

**Fees**

The Office is hereby authorized to deduct the required fee for consideration of this petition, believed to be \$ 130.00, from Deposit Account No. 01-2213 (Order No. BP9901-US).

Respectfully submitted  
On behalf of Applicants,

A handwritten signature in dark ink, appearing to read "Brian D. Gildea", is written over a horizontal line.

Brian D. Gildea; Reg. No. 39,995